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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/162,992	09/30/1998	TADASHI SENOO	P98-1703	9466

29175 7590 02/27/2003

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EXAMINER

DOVE, TRACY MAE

ART UNIT

PAPER NUMBER

1745

DATE MAILED: 02/27/2003

27

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**Application No.  
**09/162,992**

Applicant(s)

**Senoo**

Examiner

**Tracy Dove**

Art Unit

**1745**

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED Feb 19, 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see NOTE below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☒ Applicant's reply has overcome the following rejection(s):  
The objections and 35 U.S.C 112, second paragraph, rejections have been overcome.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: \_\_\_\_\_
- Claim(s) objected to: \_\_\_\_\_
- Claim(s) rejected: 2-4, 6-9, and 12
- Claim(s) withdrawn from consideration: \_\_\_\_\_
8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
10. ☒ Other: see attached sheet.

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Attachment to Advisory Action (Paper #27):

The objections and 35 U.S.C. 112, second paragraph, rejections to the claims have been withdrawn.

Applicant argues Akashi and Ozaki cannot be combined because Akashi teaches a gel electrolyte secondary cell and Ozaki teaches a non-aqueous secondary cell. However, both Akashi and Ozaki teach non-aqueous secondary cells. Examiner directs Applicant's attention to the motivation statement on page 5 of the Final Action dated 11/13/02.

Applicant argues Ozaki disfavors the use of polyethylene carbonate, let alone its use with ethylene carbonate. Neither the instant claims nor Ozaki recites the use of polyethylene carbonate as a nonaqueous solvent. Furthermore, Ozaki is cited for teachings a graphite negative electrode material for a nonaqueous cell.

It is important to note the limitation in claim 12 "obtained from a plurality of meso-carbon micro-beads" is a product-by-process limitation. The courts have ruled that product-by-process limitations, in the absence of unexpected results, are obvious. In re Fessman. Thus, since Akashi teaches a negative electrode made of a carbon material such as graphite, Akashi teaches the claim limitation "a negative electrode comprising...a graphitized carbonaceous material".

Applicant argues one skilled in the art would not modify Akashi (with Ozaki) to arrive at the claimed invention. However, Akashi teaches a negative electrode material comprising a carbonaceous material (for example, graphite) for a nonaqueous secondary cell. Ozaki teaches

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carbonaceous materials (for example, graphite) for nonaqueous secondary cells. Thus, one of skill would be motivated to combine the teachings of Akashi and Ozaki because both references teach carbonaceous materials for negative electrodes of nonaqueous secondary batteries. See also, motivation provided by the Examiner on page 5 of the Final Action dated 11/13/02.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tracy Dove whose telephone number is (703) 308-8821. The Examiner may normally be reached Monday-Thursday (9:00 AM-7:30 PM). My supervisor is Pat Ryan, who can be reached at (703) 308-2383. The Art Unit receptionist can be reached at (703) 308-0661 and the official fax numbers are 703-872-9310 (after non-final) and 703-872-9311 (after final).

  
**Patrick Ryan**  
**Supervisory Patent Examiner**  
**Technology Center 1700**

February 24, 2003